

In re Application of:  
Fernandez et al.  
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Atty. Docket No.: INVIT1120-3

## **II. REMARKS**

Upon entry of the amendment, claims 39 to 51, 54 to 57, 59 to 66, 68, 69, and 71 to 80 will be pending. A marked version of claim 76 showing the amendment is attached as Exhibit A, and a complete copy of the claims as they will stand upon entry of the present amendment is attached as Exhibit B.

### **A. Regarding the Amendment and New Claims**

Claims 52, 53, 58, 67, and 70 are cancelled herein without disclaimer, and without prejudice to Applicants' pursuing prosecution of subject matter encompassed within one or more of the claims in an application claiming the benefit of priority of the subject application.

Claim 76 has been amended to correct a typographical error, in which the claim inadvertently was shown as dependent from claim 74 instead of claim 71. The amendment is supported by the language of claim 71, which provides the requisite antecedent basis, and, therefore, does not add new matter.

New claims 77 to 80 have been added. New claim 77 is supported, for example, by originally filed claims 1 and 5, and, for example, at page 2, line 22, to page 3, line 23; and page 4, lines 4-11. New claim 78 is supported by original claim 8. New claim 79 is supported by original claim 11. New claim 80 is supported, for example, at page 5, lines 2-3. As such, the new claims are supported by the specification and the claims as originally filed and, therefore, do not add new matter. Accordingly, entry of the new claims respectfully is requested.

**B. Regarding the Restriction Requirement**

It is alleged in the Office Action that the claims are directed four independent and patentably distinct groups, as follows:

Group I: Claims 39 to 41, and 43 to 68, directed to a method of producing a library of expressible open reading frames;

Group II: Claim 42, directed to a method of producing a library of transformed cells;

Group III: Claims 69 and 70, directed to a library of expressible ORF's; and

Group IV: Claims 71 to 76, directed to a method for producing a selected library of ORF's with a 5' primer and 3' primer.

Although Applicants traverse the restriction requirement for the reasons set forth below, the claims of Group IV, claims 71 to 76, are provisionally elected in order to be fully responsive to the restriction requirement. It is submitted that newly added claims 77 to 80 are similarly directed to a method for producing a selected library of ORF's using a 5' primer and 3' primer as set forth in the claims of Group IV and, therefore, respectfully requested that the newly added claims be examined with provisionally elected claims 71 to 76.

The restriction requirement is traversed with respect to all of the Groups. As an initial matter, it is noted that no Classification and Sub-classification was indicated in the Communication. It is submitted that all of the Groups, and particularly Groups I, II and IV, would be encompassed within the same class and subclasses and, therefore, that a search of any one of the Groups would be coextensive of a search for each of the other Groups. As such, it is requested that the Groups, and particularly Groups I, II and IV be rejoined for this reason, or, in the alternative, that the Examiner set forth class and sub-class information in support of a need for different and not co-extensive searches to be performed.

Further, with respect to the claims of Groups I and II, it is submitted that the claim of Group II (claim 42), merely provides an additional step to the method of Group I. As such, it is submitted, for example, that any art relevant to examination of the claims of Group I would, of necessity be material to examination of Group II. As such, it is requested that Groups I and II be rejoined for this reason.

With respect to Groups I and II, and provisionally elected Group IV, it is submitted that the Groups of claims, while independent and patentably distinct, are sufficiently related, for example, by the requirement of a common 5' primer (5'-CACCATG) that a search relevant to Group IV would, of necessity reveal art material to examination of the claims of Group I and II. In this respect, it is noted that the 5' primer as set forth in the claims of Group IV, in part, provide the basis for the division of the claims into a separate Group. Thus, in view of the relatedness of subject matter encompassed within the claims of Groups I and II and provisionally elected Group IV, and particularly since any art revealed by a search of the 5' primer of elected Group IV would, of necessity, be relevant to the claims of Groups I and II, it is respectfully requested that these Groups of claims be rejoined.

Finally, with respect to the claims of Groups I and III, it is noted that the subject matter of Group III comprises a product produced by the methods of the claims of Group I. As such, the only way the subject matter of the claims of Group III can be obtained is by the methods of the claims of Group I and, conversely, a library produced by the method of the claims of Group I is a library as encompassed within the claims of Group III. As such, it is respectfully requested that the claims of Groups I and III be rejoined.

In summary, it is submitted, for the reasons set forth above, that the claims of all four Groups be rejoined and examined together. It is further submitted that at least the claims of Groups I and III should be rejoined, as related by a product and a process for producing the product. In addition, or alternatively, it is submitted that a search of the claims of provisionally elected Group IV, and particularly a search of the 5' primer recited in the claim, would, of

necessity, reveal art relevant to the examination of the claims of Group I, which require the same 5' primer and, therefore, that at least the claims of Groups I and IV should be rejoined.

### **C. Regarding the Species Election**

It is further stated that, if the claims of Group IV are elected, that a species of enzyme as set forth in claim 75, and a species of expression vector as set forth in claim 76 be elected. Although the species election is traversed for the reasons set forth below, the species of enzyme set forth as "vaccinia DNA topoisomerase" and the species of expression vector set forth as "eukaryotic expression" vector are provisionally elected in order to be fully responsive to the request to elect a species. It is noted that said species also are recited in newly added claims 79 and 80 and, therefore, similarly provisionally elected.

The requirement to elect a species of enzymes as set forth in claim 75 (as well as new claim 79) is traversed because, while each of the recited enzymes is independent and patentably distinct, the recited enzymes share a commonality of operation, function and effect (MPEP § 806.04(e)). Specifically, each of the recited enzymes shares the common function and effect of cleaving and ligating a DNA molecule (see, e.g., claims 74 and 78, which, it is noted, are generic with respect to claims 75 and 79, respectively). As such, it is respectfully requested that, because the enzymes as set forth in claim 75 (and claim 79) share a commonality of operation, function and effect, they should not be subject to a species election as set forth in MPEP § 806.04(e), and, therefore, respectfully requested that this species election be withdrawn, and that the recited enzymes be rejoined and examined together.

Similarly, the requirement to elect a species of expression vector as set forth in claim 76 (as well as new claim 80) is traversed because, while use of a vector for "prokaryotic expression" or "eukaryotic expression" is independent and patentably distinct, the recited vectors share a commonality of operation, function and effect (MPEP § 806.04(e)). Specifically, with respect to the present invention, the vectors, which can provide for "prokaryotic expression" and "eukaryotic expression", can encompass the same vectors; i.e., a "shuttle vector", which can allow for expression in prokaryotic cells

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and/or eukaryotic cells. Such vectors are well known and commercially available, and the requirement to "divide: a shuttle vector into one that must be used for either "prokaryotic expression" or "eukaryotic expression" is artificial. Furthermore, regardless of whether the vector is used for prokaryotic expression or eukaryotic expression, the use of the vector shares the common function and effect of providing a means to express an ORF contained in the vector. As such, it is respectfully requested that, because the expression vectors can comprise the same vector, and because for purposes of the present invention the vectors share a commonality of operation, function and effect, it is submitted that they should not be subject to a species election (MPEP § 806.04(e)). Accordingly, it is respectfully requested that this species election be reconsidered and withdrawn, and that the use of the vectors for prokaryotic expression and/or eukaryotic expression be rejoined and examined together.

In summary, the claims of Group IV, claims 71 to 76 (and newly added claims 77 to 80), and species set forth as vaccinia DNA topoisomerase, and eukaryotic expression, are provisionally elected.

It is submitted that the claims are in condition for allowance, and a notice to that effect is respectfully requested. Although no additional fee is believed to be necessary in connection with the filing of this Amendment, the Examiner is authorized to charge Deposit Account No. 50-1355 if any fee is deemed necessary.

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The Examiner is invited to contact Applicants' undersigned representative if there are any questions relating to this application.

Respectfully submitted,

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Richard J. Imbra  
Reg. No. 37,643  
Telephone: (858) 677-1496  
Facsimile: (858) 677-1465

GRAY CARY WARE & FREIDENRICH LLP  
4365 Executive Drive, Suite 1100  
San Diego, California 92121-2133  
USPTO Customer Number 28213